

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:)
Andrew COMAS *et al.*) Group Art Unit: 3628
Application Number: 09/894,476) Examiner: Clement B. GRAHAM
Filed: June 28, 2001) Confirmation No.: 5938
For: SYSTEM AND METHOD FOR) Attorney Docket No.: 72167.000564
CHARACTERIZING AND)
SELECTING TECHNOLOGY)
TRANSITION OPTIONS)

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Alexandria, VA 22313-1450

ARGUMENTS IN SUPPORT OF PRE-APPEAL-BRIEF CONFERENCE REQUEST

In response to the office action mailed September 2, 2009 ("Office Action"), Applicants respectfully request careful consideration of the below arguments in support of a pre-appeal-brief conference request.

Claims 1-12 are pending. The Office Action rejects claims 1-12 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,601,233 to Underwood ("Underwood") in view of U.S. Patent No. 6,895,382 to Srinivasan *et al.* As discussed in detail herein, the rejections are improper at least because the cited art, alone or in combination, fails to disclose each and every limitation of the pending claims.

I. Underwood Fails To Disclose Identifying And Developing Risk Factors For Unmet Opportunities

Claim 1 recites “identifying unmet opportunities” and “developing risk factors for the unmet opportunities.” The remaining independent claims contain similar limitations. The Office appears to rely on Underwood as disclosing these features. *See* Office Action, page 2. As explained below, such reliance is misplaced.

Underwood fails to consider unmet opportunities at all, let alone risk factors for unmet opportunities. The Office Action fails to point to any disclosure in Underwood that meets these limitations. *See, e.g.*, Office Action, page 2. Applicants have previously requested that the Office specify where Underwood is alleged to disclose these limitations. *See* Office Action Response of June 4, 2009 at 6 (“Applicants respectfully request, should the Office maintain its rejection, that the Office point to the specific portion of Underwood that allegedly meets these limitations [of developing risk factors for unmet opportunities]”). The Office has failed to do so. *See* Office Action, at 6-7. Applicants respectfully assert that Underwood, in fact, fails to disclose these limitations.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because Underwood fails to disclose “identifying unmet opportunities” and “developing risk factors for the unmet opportunities,” Applicants respectfully request that the rejections of the claims be withdrawn.

II. Underwood Fails To Disclose Developing Risk Factors For A Legacy Enterprise

Claim 1 recites “developing risk factors for the components of the legacy enterprise.” The remaining independent claims contain similar limitations. The Office appears to rely on Underwood as disclosing these features. *See* Office Action, page 2. As explained below, such reliance is misplaced.

Underwood is directed to generating software, rather than developing migration options. *See* Underwood, Abstract (“*A method of generating software* based on business components.”) (emphasis added). As such, Underwood is entirely unconcerned with developing migration options for an existing legacy enterprise, let alone developing risk factors for components of a legacy enterprise. Underwood has no need to consider risk factors for components of a *legacy* enterprise, because Underwood develops software from scratch. *See, e.g.*, Underwood, column 1, lines 5-7 (“The present invention relates to software framework designs and more particularly to generating software frameworks based on components of business aspects.”). Accordingly, Underwood fails to disclose or suggest “developing risk factors for the components of the legacy enterprise” as claimed.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because Underwood fails to disclose “developing risk factors for the components of the legacy enterprise,” Applicants respectfully request that the rejections of the claims be withdrawn.

CONCLUSION

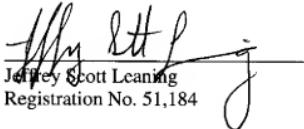
In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an indication of the same is courteously solicited.

In the event that a variant exists between the amount tendered and that determined by the U.S. Patent and Trademark Office to enter this paper or to maintain the present application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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Dated: December 2, 2009

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